

PATENT

Application No.: 09/316,546  
Attorney Do et No.: 99-012

## REMARKS

Prior to entry of this Amendment:

- Claims 1-58 were pending in the present application
- Claims 1-58 stand rejected

Upon entry of this Amendment, which is respectfully requested for the reasons set forth below:

- Claims 1-58 will be pending in the present application
- Claims 1, 6, 25, 43, 44, 51, and 56 will be amended
- Claims 1, 6, 44, 51, and 56 will be the only independent claims

### A. Telephone Interview

We would like to thank the Examiner for the helpful telephone conversation held on January 6, 2005, with our representative.

The Examiner and our representative discussed the present application in light of the cited Herman CIP.

Our representative stated that the Herman CIP did not appear to be a proper § 102(e) reference. Applicants agreed to provide arguments in this reply for the Examiner's further consideration.

While no formal agreement was reached with respect to patentability, we are grateful for the opportunity to discuss the present application with the Examiner.

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## **B. Claim Amendments**

### **B.1. Claims 25 and 43 have been amended to correct minor typographical errors**

Punctuation in Claim 25 has been corrected to recite “comprising:..”  
Claim 43 has been amended to recite “a point-of-sale terminal of the merchant.”

### **B.2. Claims 1, 6, 44, 51, and 56 have been amended**

Claims 1, 6, 44, 51, and 56 have been amended without prejudice. We submit that Claims 1, 6, 44, 51, and 56 contain allowable subject matter, were directed to statutory subject matter prior to this amendment, and that Claims 1, 6, 44, 51, and 56 have been amended solely in order to expedite issuance of the present application. We intend to pursue the original subject matter of the claims in a continuing application.

## **C. Section 101 Rejection**

Claims 1-58 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. [Office Action, pages 2-3]. We traverse this rejection as employing a standard (requirement of a claimed “technological basis”) that is not supported by relevant, precedential case law.

We submit that as all pending claims produce a useful, concrete and tangible result the claims are directed to statutory subject matter under § 101.

However, solely in order to expedite allowance of the present application, independent Claims 1, 6, 44, 51 and 56 have been amended in order to attempt to comply with the Examiner’s novel standard requiring a “technological basis.” Claims 1, 6, and 43 each recite a step performed via an electronic communications network. Claim 51 recites a step of registering, via a computing device... Claim 56 recites a step in which a received record of charge is printed by a point of-sale terminal.

We respectfully request reconsideration of the § 101 rejection of Claim 1-58.

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#### **D. Section 102(e) and Section 103(a) Rejections**

All of the pending claims (Claims 1-58) stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,341,353 issued to Herman et al. ("the Herman CIP") or under 35 U.S.C. 103(a) as unpatentable over Herman in view of U.S. Patent No. 6,161,059 issued to Tedesco et al. ("Tedesco").

The Herman CIP is a continuation-in-part (CIP) of U.S. Patent Application No. 08/834027, filed April 11, 1997, which issued to Martinez et al. on September 12, 2000 as U.S. Patent No. 6,119,229 (hereinafter "the Martinez patent"). The Herman CIP also claims the benefit of 60/111988 ("the Herman provisional"), filed December 12, 1998.

We respectfully traverse the Examiner's Section 102(e) rejection and Section 103(a) rejections.

#### **D.1. Introduction**

We respectfully submit that the Examiner has not established a *prima facie* case of anticipation or obviousness for any of the independent claims (Claims 1, 6, 44, 51, and 56).

There is no evidence that any of the subject matter disclosed in the Herman CIP and relied upon by the Examiner is actually prior art with respect to the present application.

All of the prior art rejections rely on citations to the Herman CIP. The Examiner has not shown, however, that the Martinez patent or the Herman provisional actually discloses the subject matter relied on by the Examiner for the prior art rejections, and does not appear to have reviewed those disclosures.

Until the Examiner makes a finding that the pending claims could have been rejected in light of subject matter disclosed in the Martinez patent or the Herman provisional, the Herman CIP cannot be applied as a prior art reference against any pending claim.

See MPEP §§ 706.02(f)(1), 2136.03 (III-IV) ("In order to carry back the 35 U.S.C. 102(e) critical date of the U.S. patent reference to the filing date of a parent application, ...the parent application must support the invention claimed as required by 35 U.S.C. 112, first paragraph.") (emphasis added).

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**D.2. The Herman CIP patent was filed after the present application**

The application that issued as the Herman CIP was filed *after* the present application. The Herman CIP is not prior art based on its actual filing date.

**D.3. Findings required for applying a § 102(e) reference**

MPEP (8<sup>th</sup> ed., Rev. 2, May 2004) provides explicit instructions for making the findings necessary to establish a reference as a § 102(e) reference (underlining added):

**§ 706.02(f)(1) Examination Guidelines for Applying References Under 35 U.S.C. 102(e) [R-2]**

I. DETERMINE THE APPROPRIATE 35 U.S.C. 102(e) >DATE< FOR EACH POTENTIAL REFERENCE BY FOLLOWING THE GUIDELINES, EXAMPLES, AND FLOW CHARTS SET FORTH BELOW:

(A) The potential reference must be a U.S. patent, a U.S. application publication (35 U.S.C. 122(b)) or a WIPO publication of an international application under PCT Article 21(2) in order to apply the reference under 35 U.S.C. 102(e).

(B) ...The 35 U.S.C. 102(e) date of a reference that did not result from, nor claimed the benefit of, an international application is its earliest effective U.S. filing date, taking into consideration any proper benefit claims to prior U.S. applications under 35 U.S.C. 119(e) or 120 if the prior application(s) properly supports the subject matter used to make the rejection \*\*>in compliance with 35 U.S.C. 112, first paragraph. See MPEP § 2136.02<.

MPEP § 2136.03 (IV) states: "In order to carry back the 35 U.S.C. 102(e) critical date of the U.S. patent reference to the filing date of a parent application, ...the parent application must support the invention claimed as required by 35 U.S.C. 112, first paragraph."

Similarly, MPEP § 2136.03 (III) states: "The 35 U.S.C. 102(e) critical reference date of a U.S. patent...entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application...if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph."

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**D.4. The Examiner has not established that any asserted subject matter of the Herman CIP is prior art**

The Examiner has not made the proper findings required in order to assert that any of the subject matter of the Herman CIP used to make the § 102(e) and § 103(a) rejections is actually prior art with respect to the present application.

The Examiner does not appear to have followed the MPEP guideline for determining whether the Herman CIP is a proper § 102(e) reference. As noted above, examiners are instructed by the MPEP to determine whether the prior application(s) properly support the subject matter used to make the rejections. Per the MPEP, an examiner cannot simply conclude that the date of a prior application is an appropriate § 102(e) reference date.

The Examiner has not articulated or made of record any reasoned finding as to the priority of the subject matter of the Herman CIP used to make any rejection. There is no evidence that the Examiner has determined if any of the prior applications properly supports the subject matter of the Herman CIP used to make the rejections, in compliance with 35 U.S.C. 112, first paragraph.

The Examiner does not even mention the prior-filed applications to which the Herman CIP claims priority. The Examiner does not mention and does not appear to have considered whether any claim could be rejected in light of the disclosure of the Martinez patent or the Herman provisional.

Thus, the Examiner has not made of record the findings indicated in the MPEP as being necessary to establish the priority of the asserted subject matter of the Herman CIP. There is no substantial evidence that the asserted subject matter was known prior to the filing of the present application. As every § 102(e) or § 103(a) rejection relies on matter in the Herman CIP, the Examiner has failed to establish a *prima facie* case that any claim is anticipated or obvious.

**D.5. Conclusion**

The Examiner does not provide any evidence that any subject matter of the Herman CIP relied on by the Examiner is adequately disclosed in either the Martinez patent or the Herman provisional such that a claim could have been rejected based on either of those earlier applications.

The Examiner does not appear to have determined what matter in the Herman CIP is actually prior art with respect to the present application, and what matter was disclosed only after the filing of the present application. There is no evidence of any such determination.

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Accordingly, the Examiner's reliance on the disclosure of the Herman CIP alone cannot constitute substantial evidence supporting any prior art rejection. Without a reasoned and articulated finding establishing that the asserted subject matter disclosed in the Herman CIP is actually prior art, the Examiner has failed to establish a *prima facie* case of either anticipation or obviousness with respect to any claim.

We respectfully request the Examiner's reconsideration of the § 102 (e) and § 103(a) rejections of all of the pending claims.

For at least the reasons stated herein, we respectfully request allowance of the pending Claims **1-58**.

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### **E. Authorization to Charge Appropriate Fees**

We do not believe that any fees are necessary for this response.

Please grant a petition for any extension of time required to make this Response timely.

If necessary, please charge any appropriate fees necessary per the following information:

Deposit Account: 50-0271

Order No.: 99-012

Please credit any overpayment to the same account.

*A duplicate copy of this authorization is enclosed for such purposes.*

### **F. Conclusion**

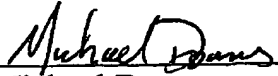
It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at [mtdowns@walkerdigital.com](mailto:mtdowns@walkerdigital.com).

Respectfully submitted,

March 16, 2005

Date

  
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